

UNITED STATES DISTRICT COURT

Northern District of California

San Francisco Division

DENSO CORPORATION, a Japanese
Corporation,

No. C 14-01050 LB

Plaintiff,

v.

Domain Name <denso.com>,

Defendant.

**ORDER DENYING PLAINTIFF'S
MOTION FOR WAIVER OF
SERVICE BY PUBLICATION,
DENYING MOTION TO DISMISS,
AND DENYING MOTION TO
APPOINT COUNSEL**

[ECF Nos. 19, 22, 23]

INTRODUCTION

Plaintiff Denso Corporation filed this action under the Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d), seeking to recover the domain name denso.com, from the current domain registrant, Densoft Consultancy Services Ltd. ("DCS"), which is located in the United Kingdom. *See* First Amended Complaint ("FAC"), ECF No. 26, ¶¶ 4, 29. There are a number of motions pending. First, Denso asks the court to waive the ACPA's service by publication requirement. *See* ECF No. 19. Second, the court received several e-mail messages with attached documents from a Yuri Yasmanov, who claims to be a director of DCS. *See* ECF Nos. 22-23. These include a motion to dismiss, ECF No. 22, and a motion to either (1) extend the case management deadlines to allow DCS to retain counsel or (2) appoint counsel for DCS, ECF No. 23. The court filed these documents for Mr. Yasmanov, which is the standard practice when the court receives substantive documents on an *ex parte* basis. For the reasons discussed below, the court

DENIES Denso's motion to waive the ACPA's service by publication requirement, and **DENIES** Mr. Yasmanov's requests.

STATEMENT

I. BACKGROUND

Denso is a Japanese corporation with its principal place of business in Japan. FAC ¶ 1. It supplies advanced automotive technology, systems, and components for automakers, operates in 30 countries, and has about 130,000 employees. *Id.* ¶ 2. Denso previously owned the denso.com domain name, which it used in association with its website, its business, and corresponding DENSO trademarks. *Id.* ¶ 3. Denso.com is registered in a domain name registry that is operated by VeriSign, Inc. *Id.* VeriSign's principal place of business is in San Francisco, California. *Id.*

On March 6, 2000, Denso mistakenly allowed its registration of the denso.com domain to lapse. *See id.* ¶¶ 15-18. One week later, a Russian company registered the domain. *Id.* ¶ 19. The registrant subsequently transferred the ownership several times in an attempt to make it difficult for Denso to contact the real registrant. *Id.* ¶ 20.

Since 2001, Denso has made several attempts to reacquire the domain. *See id.* ¶¶ 21-30. It located and contacted the registrant in 2001. *Id.* ¶¶ 21-23. In 2003, Denso filed an administrative action under ICANN's Uniform Dispute Resolution Policy to recover the domain. *Id.* ¶¶ 5, 24. On November 3, 2003, the World Intellectual Property Organization arbitration panel ordered the domain to be transferred to Denso. *Id.* ¶ 25. Despite the WIPO ruling, the registrant and registrar refused to transfer the domain to Denso. *Id.* ¶ 26.

The registrant then filed a claim with the Russian Arbitrazh Court of the City of St. Petersburg and the Leningrad Region disputing Denso's right to the domain. *Id.* ¶ 27. After numerous appeals, Denso prevailed in the Russian Supreme Court in a published decision dated November 11, 2008. Still, the domain's registrant and registrar refused to transfer the domain to Denso. *Id.*

II. PROCEDURAL HISTORY

Denso filed this action on March 6, 2014. *See* Complaint, ECF No. 1. The original complaint named denso.com as an in rem defendant and denso.com's then-unknown registrant as a Doe defendant. *See id.* ¶ 4. Denso explained that it could not identify the denso.com registrant "as they

1 are registered via a ‘WHOIS privacy’ service located in Russia.” Complaint, ECF No. 1, ¶ 4. The
2 Complaint asserted claims for (1) cyberpiracy under the ACPA, 15 U.S.C. § 1125(d)(1)(A), (2)
3 conversion, (3) common law unfair competition, and (4) unfair competition under California
4 Business and Professions Code § 17200. *Id.* ¶¶ 31-50.

5 On March 13, 2014, Denso moved for an order directing VeriSign to place the denso.com
6 domain on “registry lock status,” so that it could not be transferred, suspended, or otherwise
7 modified during the pendency of this action without a court order. *See* Motion, ECF No. 7. The
8 court granted Denso’s motion on March 17, 2014. *See* Order, ECF No. 8.

9 On April 17, 2014, the court received a e-mail and letter allegedly from Alexey Gromov of
10 Fiducia LLC, LATVIJAS PARSTAVNIECIBA, regarding this matter. *See* ECF No. 11. Mr.
11 Gromov claims that Fiducia, which is located in Latvia, is the registrar of denso.com. *Id.* at 2. He
12 states that Fiducia is seeking legal advice in connection with this matter and asks that “the court take
13 no further action in this case and suspend a time-table for this case.” *Id.*

14 On August 20, 2014, Denso filed a proof of service indicating that it mailed and e-mailed the
15 Complaint and other pleadings in this case to the registrant, which was located in the United
16 Kingdom. *See* Proof of Service, ECF No. 16. It also filed a Case Management Conference in which
17 it explained that Denso’s counsel had been contacted by an attorney named Steven Svoboda who
18 had been retained by the “defendant.” *See* CMC Statement, ECF No. 17 at 3. Mr. Svoboda said that
19 he represented DCS, the company listed as the denso.com domain name registrant. *Id.* On August
20 18, 2014, Mr. Svoboda notified Denso’s counsel that he no longer represented DCS in this
21 proceeding. *Id.* Also on August 20, 2014, Plaintiffs filed a motion asking the court to waive the
22 ACPA’s service by publication requirement. *See* Motion for Waiver, ECF No. 19.

23 On August 21, the court received an e-mail message and attachments from a Yuri Yasmanov of
24 DCS. *See* ECF No. 20. The attachments included a Case Management Statement in which Mr.
25 Yasmanov makes legal arguments about the merits of Denso’s case, and asks the court to dismiss
26 Denso’s complaint and award DCS damages, attorneys’ fees, and costs. *Id.* The statement indicates
27 that DCS decided “to insource this case to the in-house lawyers which can not be so keen on and
28 familiar with the peculiarities of ACPA and other applicable US laws and regulations.” *Id.* at 5.

On August 22, 2014, Alexei Gromov of Fiducia e-mailed another case management statement to the court along with several attachments. *See* ECF No. 21 (filed by the court on August 26, 2014).

On August 27, 2014, DCS e-mailed two purported motions to the court. *See* ECF Nos. 22-23. First, DCS sent a motion to dismiss. Motion to Dismiss, ECF No. 22. Second, DCS sent a motion asking the court to vacate the case management conference that was scheduled for August 28, 2014 so that DCS would have time to retain new counsel, or alternatively, to appoint counsel for DCS. Motion to Appoint Counsel, ECF No. 23. Both motions are signed by “Mr. Yuri Yasmanov, Densoft Consultancy Services Ltd. Pro Se.” Motion to Dismiss, ECF No. 22 at 2; Motion to Appoint Counsel, ECF No. 23 at 2. The court later continued the Case Management Conference to October 2, 2014. *See* 8/28/2014 Clerk’s Notice, ECF No. 25.

On September 10, 2014, Denso filed the operative First Amended Complaint. FAC, ECF No. 26. The FAC drops the claims against the Doe Defendants and asserts only an in rem claim against denso.com. *See* FAC, ECF No. 26. Denso also opposed both of DCS’s motions. *See* Response to Motion to Dismiss, ECF No. 27; Response to Motion to Appoint Counsel, ECF No. 28.

Finally, on September 17, 2014, Mr. Gromov filed another case management conference statement on behalf of Fiducia. *See* ECF No. 29.

ANALYSIS

This order addresses the following issues: (1) Mr. Yasmanov’s and Mr. Gromov’s attempts to file documents on behalf of unrepresented business entities, including DCS’s motion to dismiss and motion to appoint counsel, and (2) Denso’s motion to waive the ACPA’s service by publication requirement.

I. BUSINESS ENTITIES MAY NOT APPEAR PRO SE

The court first addresses the issues arising Mr. Yasmanov’s attempts appear on behalf of DCS and Mr. Gromov’s attempts to file case management conference statements on behalf of Fiducia. Civil Local Rule 3-9(b) provides that “[a] corporation, unincorporated association, partnership or other such entity may appear only through a member of the bar of this court.” *Accord McGowan v. Boek*, 402 F. App’x 287, 288 (9th Cir. 2010) (affirming dismissal of case because corporate plaintiff was not represented by counsel) (collecting cases); *In re Highley*, 459 F.2d 554, 555 (9th Cir. 1972)

1 (“A corporation can appear in a court proceeding only through an attorney at law.”) (collecting
2 cases). DCS and Fiducia, respectively, are U.K. and Latvian business entities. Accordingly, they
3 may not appear in this action unless they retain appropriate counsel.

4 Denso contends that the court should strike DCS’s motions from the record. *See* Opp’n to
5 Motion to Dismiss, ECF No. 27 at 5; Opp’n to Motion to Appoint Counsel, ECF No. 28 at 4. The
6 court agrees.

7 Under Rule 12(f), a court “may strike from a pleading an insufficient defense or any redundant,
8 immaterial, impertinent, or scandalous matter.” The purpose of a Rule 12(f) motion is to avoid
9 spending time and money litigating spurious issues. *Whittlestone, Inc. v. Handi-Craft Co.*, 618 F.3d
10 970, 973-74 (9th Cir. 2010). Motions to strike “are generally disfavored because the motions may
11 be used as delaying tactics and because of the strong policy favoring resolution of the merits.”
12 *Barnes*, 718 F. Supp. 2d at 1170. The ultimate decision under Rule 12(f) lies within the sound
13 discretion of the court. *See Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1528 (9th Cir. 1993), *rev’d on*
14 *other grounds*, 51 U.S. 517, 534-35 (1994).

15 Federal courts have granted motions to strike in nearly identical circumstances to those in this
16 case. *See Wolfe v. Rodriguez*, No. 13-60709-CIV, 2013 WL 6885176, *4-5 (S.D. Fla. Dec. 31,
17 2013) (affirming Bankruptcy Court finding that a party who assigned a lien “from himself and his
18 wife in their corporate capacities, to himself, individually” lacked standing because the assignment
19 agreement was an attempt to circumvent the requirement that corporations must appear through
20 counsel, and striking the pleadings on that basis); *Lady Kelly, Inc. v. U.S. Sec’y of Agr.*, 30 C.I.T. 82,
21 84 (2006) (“Plaintiff’s response to Defendant’s motion to dismiss must be stricken from the record
22 because a corporation may not appear *pro se*, and must appear in court by an attorney.”); *United*
23 *States v. Neman Bros. & Associates*, 17 C.I.T. 181, 181 (1993) (striking answer filed by pro se
24 corporate defendant).

25 Accordingly, the court strikes DCS’s motion to appear and motion to appoint counsel. DCS and
26 Fiducia may not file documents in this case unless and until they are represented by attorneys
27 admitted to the bar of this court.
28

1 II. DCS'S MOTION TO DISMISS IS MOOT

2 Even if the court were to consider DCS's motion to dismiss, it would deny it as moot. After
3 DCS e-mailed its motion to the court, Denso filed an amended complaint. *See* Docket. Because
4 DCS's motion was directed to a complaint that is no longer operative, the motion is moot.

5 III. DENSO'S MOTION TO WAIVE SERVICE BY PUBLICATION

6 In the FAC, Denso asserts one claim under the ACPA, 15 U.S.C. § 1125(d). The ACPA contains
7 provisions designed to protect trademark owners from cybersquatters – individuals and entities that
8 have registered domains containing a protected mark. *See* 15 U.S.C. § 1125. It allows the owner of
9 a mark to file suit against a person who (1) “has a bad faith intent to profit from that mark . . . ; and
10 (2) register, traffics in, or uses a domain name that violates rights in the protected mark. *Id.*
11 § 1125(d)(1)(A). The ACPA also allows the owner of a protected mark to file an in rem action
12 against a domain name upon a court finding that the mark owner either: (1) is not able to obtain in
13 personam jurisdiction over a person who would have been a defendant under § 1125(d)(1), or (2)
14 through due diligence was not able to find such a person under 15 U.S.C. § 1125(d)(1). *See* 15
15 U.S.C. § 1125(d)(2)(A). The relevant provisions state:

16 **(2)(A)** The owner of a mark may file an in rem civil action against a domain name in the
17 judicial district in which the domain name registrar, domain name registry, or other domain
name authority that registered or assigned the domain name is located if–

18 **(i)** the domain name violates any right of the owner of a mark registered in the Patent
and Trademark Office, or protected under subsection (a) or (c) of this section; and

19 **(ii)** the court finds that the owner–

20 **(I)** is not able to obtain in personam jurisdiction over a person who would have
21 been a defendant in a civil action under paragraph (1); or

22 **(II)** through due diligence was not able to find a person who would have been a
23 defendant in a civil action under paragraph (1) by–

24 **(aa)** sending a notice of the alleged violation and intent to proceed under
this paragraph to the registrant of the domain name at the postal and e-
25 mail address provided by the registrant to the registrar; and

26 **(bb)** publishing notice of the action as the court may direct promptly after
filing the action.

27 15 U.S.C. § 1125(d)(2)(A). The mark owner can effect service of process if the court finds that
28 there is no in personam jurisdiction and the plaintiff fulfills the notice requirements of subparagraph

1 1125(d)(2)(A)(ii)(II). *Id.* § 1125(d)(2)(B); *see Con-Way Inc. v. CONWAYRACING.COM*, No. 08-
2 4263 SC, 2009 WL 2252128, at *2 (N.D. Cal. July 28, 2009). In an in rem action under the ACPA,
3 a domain name is deemed to have its situs in the judicial district in which the domain name registrar,
4 registry, or other domain name authority that registered or assigned the domain name is located. 15
5 U.S.C. § 1125(d)(2)(C)(i).

6 In its motion, Denso asks the court to waive the service by publication requirement of
7 § 1125(d)(2)(A)(ii)(bb). *See* Motion for Waiver, ECF No. 19 at 4-5. It argues that service by
8 publication is unnecessary because DCS already has actual notice of this action. *Id.* The court
9 denies Denso's motion as prematurely filed.

10 Denso has not completed the prerequisites necessary for asserting an in rem claim. In order to
11 bring an in rem action under the ACPA, Denso must prove, and the court must find, that the owner is
12 unable to locate or obtain in personam jurisdiction over the person who should be the defendant in
13 an in personam ACPA action under § 1125(d)(1). *See* 15 U.S.C. § 1125(d)(2)(A)(ii). Here, the
14 defendant in an in personam action would be DCS. *See* Motion for Waiver at 4. Denso has located
15 DCS. *See* Rodenbaugh Decl., ECF No. 19-1, ¶ 3. Thus, Denso can only proceed in rem if the court
16 finds that Denso cannot obtain in personam jurisdiction over DCS. Denso has not asked the court
17 for that finding and personal jurisdiction may not be an issue.

18 DCS's attempted filings suggest that it might not contest personal jurisdiction (and may already
19 have waived its right to do so). DCS responded to the original complaint, which named the
20 unidentified registrant as a Doe Defendant. *See* Complaint, ECF No. 1, ¶ 4. DCS obtained counsel
21 to represent it (however briefly), attempted to appear pro se and file motions, and repeatedly
22 contacted the court regarding this matter.

23 Other district court rulings suggest that it would be premature to grant Denso's motion. For
24 example, in *Con-Way*, which Denso cites in support of its motion, the court granted a motion to
25 waive the ACPA's service by publication requirement. *See* 2009 WL 2252128, at *3. Before
26 granting the motion, the court explained that in an earlier motion, the plaintiff "requested that this
27 Court find that it could not obtain in personam jurisdiction over a proper ACPA defendant, and this
28 Court found that in personam jurisdiction was indeed lacking." *See id.* at *2. Denso has not yet

1 made that showing. The court, therefore denies its motion without prejudice.

2 **CONCLUSION**

3 The court **DENIES** without prejudice Denso's motion to waive the ACPA's service by
4 publication requirement and **STRIKES** DCS's motions to dismiss and appoint counsel.

5 This disposes of ECF Nos. 19, 22, and 23.

6 **IT IS SO ORDERED.**

7 Dated: September 19, 2014

8 
LAUREL BEELER
United States Magistrate Judge